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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,870	04/28/2006	Tomokazu Obata	TAN-119	3325
54630 7590 12/08/2008 ROBERTS & ROBERTS, LLP ATTORNEYS AT LAW P.O. BOX 484 PRINCETON, NJ 08542-0484				
EXAMINER				
FOGARTY, CAITLIN ANNE				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
12/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/577,870

Applicant(s)

OBATA ET AL.

Examiner

CAITLIN FOGARTY

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-8 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1, 4 – 8, and 11 – 20 are pending where claims 1 and 4 – 8 have been amended. Claims 12 – 20 have been withdrawn from consideration as a result of a restriction requirement and claims 2, 3, 9 and 10 have been cancelled.

Status of Previous Rejections

2. The 35 U.S.C. 102(b) rejection of claims 1 – 3, 6 – 8, and 11 as being anticipated by the English machine translation of JP 2002-226927 has been withdrawn in view of the amendment filed September 5, 2008.

The 35 U.S.C. 102(b) rejection of claims 1, 3, 5 – 8, and 11 as being anticipated by Nakai et al. (US 2002/0150772) has been withdrawn in view of the amendment filed September 5, 2008.

The 35 U.S.C. 102(b) rejection of claims 1 and 4 as being anticipated by Ohno et al. (US 2002/0114915) has been withdrawn in view of the amendment filed September 5, 2008.

The 35 U.S.C. 103(a) rejection of claims 9 and 10 as being unpatentable over the English machine translation of JP 2002-226927 has been withdrawn in view of the amendment filed September 5, 2008.

35 U.S.C. 103(a) rejection of claims 9 and 10 as being unpatentable over Nakai et al. (US 2002/0150772) has been withdrawn in view of the amendment filed September 5, 2008.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 4 – 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno et al. (US 2002/0114915).

With respect to instant claims 1 and 4 – 8, [0132], [0133], and [0135] of Ohno teach a silver alloy for use in a reflective film comprising silver as a main element and up to 10 atomic % of impurity elements where the impurity elements include rare earth elements (includes erbium), indium, gallium, copper, palladium, and gold. The composition of the dopant elements of Ohno overlaps with the compositional range recited in the instant claims. The silver alloy of Ohno satisfies the “consisting essentially of” instant claim limitation because it does not require any additional elements that are not present in the instant claims. Although Ohno does not specifically disclose the presence of erbium, it teaches that the silver alloy includes rare earth elements which includes erbium. The Examiner takes the position that it would be obvious to use erbium as the rare earth element in the silver alloy of Ohno in absence of factual evidence as to why it would not be obvious.

In regards to instant claim 11, [0181] of Ohno discloses that the silver alloy may be used as a sputtering target.

Since the claimed compositional ranges of claims 1, 4 – 8, and 11 either overlap or are within the ranges disclosed by Ohno, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed silver alloy composition from the silver alloy composition disclosed by Ohno because Ohno teaches the same utility (i.e. use in a reflective film) in the whole disclosed range.

6. Claims 1, 6, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over the English machine translation of JP 2003-113433 (hereafter JP '433).

With respect to instant claims 1, 6, and 7, [0012]-[0014] of JP '433 teach a silver alloy for use in a reflective film comprising silver as a main element, 0.1-2 atomic% erbium as a first dopant element, and at least one of 0.1-3 atomic% copper and gold as a second dopant element. The composition of the dopant elements of JP '433 overlaps with the compositional range recited in the instant claims. The silver alloy of JP '433 satisfies the "consisting essentially of" instant claim limitation because it does not require any additional elements that are not present in the instant claims.

Regarding instant claim 11, [0014] of JP '433 discloses that the silver alloy may be used as a sputtering target.

Since the claimed compositional ranges of claims 1, 6, 7, and 11 either overlap or are within the ranges disclosed by JP '433, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed silver alloy composition from the

silver alloy composition disclosed by JP '433 because JP '433 teaches the same utility (i.e. use in a reflective film) in the whole disclosed range.

Response to Arguments

7. Applicant's arguments with respect to claims 1 – 11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

CF